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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,623	07/18/2000	Richard W. Gross	15060-0004	9309

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EXAMINER

PAK, YONG D

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 01/28/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,623

Applicant(s)

GROSS ET AL.

Examiner

Yong Pak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 9-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

The amendment filed on November 4, 2002, amending claims 3 and 6-8 and amending the specification, has been entered.

Claims 1-37 are pending.

Rejections and/or objections not reiterated from previous Office action are hereby withdrawn.

Election/Restrictions

Claims 9-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

In light of the amendment, which states that SEQ ID NO:2 is the cDNA of the coding region of the enzyme of SEQ ID NO:1, the examiner notes that Group I is drawn to DNA of SEQ ID NO:2 instead of SEQ ID NO:3 and claim 6 has been rejoined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is drawn to a nucleic acid fragment that hybridizes to a sequence set forth in SEQ ID NO:1. The claim is confusing because SEQ ID NO:1 is an amino acid sequence and therefore can not hybridize to DNA.

Response to Arguments

Applicant's arguments filed November 4, 2002 have been fully considered but they are not persuasive.

Specification

The sequence Rules 1.821 (c) requires a sequence identifier for each sequence. However, the same amino acid sequence is identified by different sequence identifier. SEQ ID NOs: 1 and 5 are 100% identical. Applicants have not corrected this duplicity.

The specification still contains conflicting definitions of SEQ ID NO:2. The sequence listing defines SEQ ID NO:2 as a DNA sequence of 2349 bases encoding SEQ ID NO:1. However, the specification defines SEQ ID NO:2 as both a DNA sequence and a encoded polypeptide (see page 4).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 4-5 and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as

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to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants argue that the specification describes variants in the genus. The examiner disagrees. Claims 1-2 are drawn to a wide genus of DNA encoding a phospholipase A_{2γ} having any structure and derived from any source.

Regarding claim 7, applicants argue that the specification describes polypeptides substantially identical to and which are biologically equivalent to the phospholipase A_{2γ}. While this is true, the claim is drawn to a DNA molecule having 90% homology to SEQ ID NO:2 having phospholipase A_{2γ} activity, no activity or unknown activity. The specification only describes DNA encoding a polypeptide with phospholipase A_{2γ} activity.

Claims 1-2, 4-5 and 7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the polynucleotide encoding the phospholipase A_{2γ} of SEQ ID NO: 1, does not reasonably provide enablement for polypeptides with structures different from SEQ ID NO:1. The specification does not reasonably provide enablement for variant polypeptides of SEQ ID NO: 1 having unknown function. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

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Applicants argue that the specification is enabling for all phospholipase A_{2γ} all variants of phospholipase A_{2γ}. The examiner disagrees. Claims 1-2 are drawn to DNA encoding a phospholipase A_{2γ} having any structure and derived from any source.

Regarding claim 7, applicants argue that the specification is enabling in that the specification teaches polypeptides substantially identical to and which are biologically equivalent to the phospholipase A_{2γ}. While this is true, the claim is drawn to a DNA molecule having 90% homology to SEQ ID NO:2 with unlimited function. As applicants have stated in page 11 of the Remarks, small modifications, such as around amino acids 481-485, will have effect on the functional properties of the polypeptide. Therefore, even though claim 7 is drawn to a DNA molecule having high homology to SEQ ID NO:2, the DNA molecule in this claim encompasses DNA molecules encoding polypeptides having phospholipase A_{2γ} activity, no activity or unknown activity. The function of a polypeptide can not be predicted from its structure and the specification does not teach how to use polypeptides with unknown function. Therefore, the breadth of these claims is much larger than the scope enabled by the specification.

Claim Rejections - 35 USC § 102

Claims 1-2 and 4-5 remain rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al.

Applicants argue that the claimed invention is patentably distinct over Jones et al. in that the claimed invention is encoded by separate gene on a different chromosomes. While this maybe true, the claims are drawn to a DNA molecule

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encoding a phospholipase A₂, wherein the enzyme catalyzes the *sn*-2 position of phospholipids. The claims are not drawn to DNA encoding SEQ ID NO:1. Therefore, the teachings of Jones et al. anticipate claims 1-2 and 4-5.

Response to Amendment

Claim Rejections - 35 USC § 102

The declaration filed on November 4, 2002 under 37 CFR 1.131 is sufficient to overcome the Mancuso et al. reference.

Allowable Subject Matter

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

No claims are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on 8:00 A.M. to 4:30 P.M weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong Pak
Patent Examiner

January 24, 2003



PONNATHAPU ACHUTAMURTHY
SUPERVISOR / PATENT EXAMINER
703-308-3804